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March 4, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Examiner: P.T. Bui  
Art Unit: 1638  
Conf. No.: 1056  
Appeal No.: 2005-0837

Re: U.S. Patent Application No. 09/938,294 filed August 24, 2001  
Inventors: Gregory J. HINKLE *et al.*  
Title: Novel Plant Transcribed Regions and Uses Thereof  
Atty. Dkt: 16517.253

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Request for Suspension of Appeal; and
2. Return postcard.

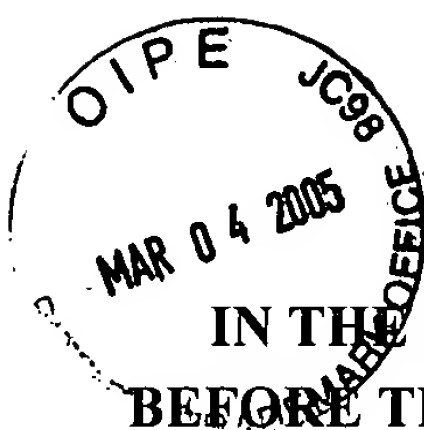
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any additional fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.253. A duplicate copy of this letter is attached.

Respectfully submitted,

Thomas E. Holsten (Reg. No. 46,098)

Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Gregory J. HINKLE *et al.*

Appln. No.: 09/938,294

Filed: August 24, 2001

Title: Novel Plant Transcribed Regions  
and Uses Thereof

Art Unit: 1638

Examiner: Phuong T. Bui

Appeal No.: 2005-0837

Conf. No. 1638

Atty. Dkt. No.: 16517.253

### Request for Suspension of Appeal

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The legal issue presented in the above-captioned appeal is similar to the issue presented in an appeal currently before the United States Court of the Appeals for the Federal Circuit ("Federal Circuit").

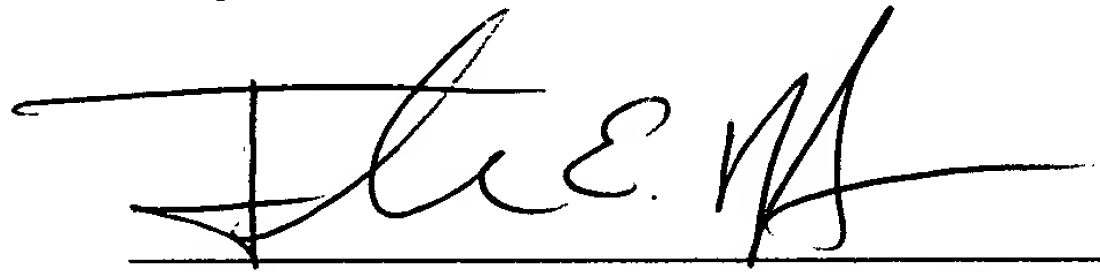
On March 31, 2004, Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on June 1, 2004. The issue presented in the above-captioned appeal relates to the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher*. (U.S. Appln No. 09/619,643, B.P.A.I. Appeal No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in

the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8<sup>th</sup> Edition, Revision No. 2, at page 1200-31. For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "T.E. Holsten" followed by a flourish, and "D.R. Marsh" written below it.

Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)

Date: March 4, 2005

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